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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,988

10/05/2005

Gerhard Hamprecht

3165-137

6444

6449

7590

09/24/2009

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

1425 K STREET, N.W.

SUITE 800

WASHINGTON, DC 20005

EXAMINER

MABRY, JOHN

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

09/24/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,988	<b>Applicant(s)</b> HAMPRECHT ET AL.	
	<b>Examiner</b> JOHN MABRY	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16, 17 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-17 and 22-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2009 has been entered.

***Response to Amendment(s)***

Applicant's response on June 25, 2009 filed in response to the Office Action dated January 2, 2009 has been received and duly noted. An Advisory Action was sent by Examiner and an After-Final Amendment was received from Applicant on same day.

In view of this response, the status of the rejections/objections of record is as follows:

***Status of the Claims***

Claims 16-17 and 22-23 are pending and rejected.

Claims 1-15, 18-19 and 28-39 have been cancelled.

Claims 20-21 and 24-27 are directed towards non-elected subject matter.

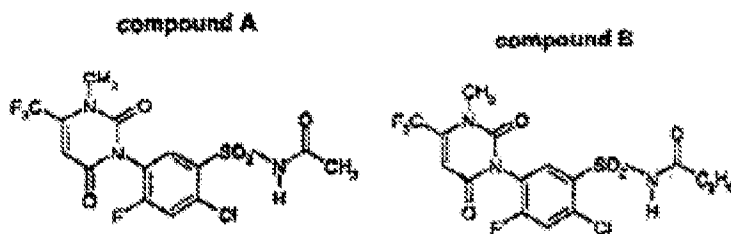
***Claim Rejections - 35 USC § 103***

Claims 16-19 and 22-23 rejections are maintained under 35 U.S.C. 103(a) as being unpatentable over Strunk et al (US 5,169,430).

Applicant's arguments with respect to 103(a) rejections have been fully considered and are not persuasive. Applicant has not compared the closest art as clearly described in previous Office Action (see below).

Applicant argues that the test data submitted in the 132 Declaration clearly demonstrates a head-to-head demonstration comparison of the claimed invention with that of the prior art of Strunk (US '430). Applicant states that the closest examples of Strunk are compounds 40 and 67; Examiner respectfully disagrees. As Examiner clearly states in previous Final Office Action

Applicant has compared compounds A and B as described in Rule 132 declaration (see compounds below).

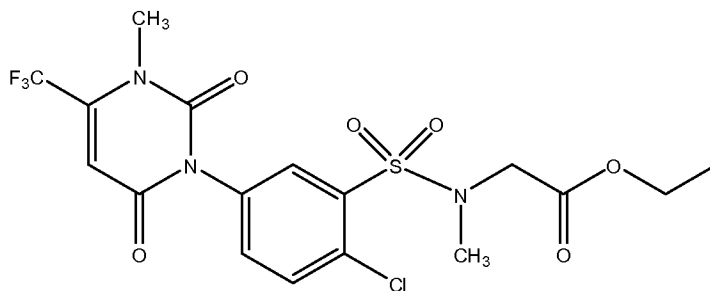


The compounds (A – compound 40 and B – compound 67 of US '430) that Applicant is comparing are not the compounds that Examiner has specifically pointed out and used in rejection against the instant application. Applicant has not compared the closest art as clearly described in previous Office Action (see above). Applicant is comparing the replacement of the alkylcarbonyl-aminosulfonyl side chain versus alkoxycarbonyl-aminosulfonyl side chain.

Strunk discloses compounds and pharmaceutical compositions of Formula I wherein X1/Y1=halogen, X3=CH3, Q=Q21, Y-R1=-C(O)O-C2H5 (see Compound No.

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41, column 23/24, Table I) which Examiner clearly indicated as the closest related species.



Secondly, Applicant acknowledged but did not address the Examiner's obviousness argument regarding how Strunk differs from the instant application at the -N-Y- position: Strunk's -NCH<sub>3</sub>-CH<sub>2</sub>-CO<sub>2</sub>CH<sub>2</sub>CH<sub>3</sub> versus Applicants' -NCH<sub>3</sub>-CO<sub>2</sub>CH<sub>2</sub>CH<sub>3</sub> - a difference of the -CH<sub>2</sub>-. Strunk also discloses and teaches compounds without the -CH<sub>2</sub>- group directly linked to the C=O group or an -O-alkyl group. Teaching the equivalence of these groups. This obviousness rejection has not been properly addressed; therefore, rejection against the instant invention is maintained.

Examiner acknowledges Applicant's amendments regarding claimed variables X1 and X3. These amendments would still be considered obvious over Strunk et al (US '430) as Strunk teaches and discloses compounds of the currently amended claims. For instance, Strunk teaches X1 to be halogen (see definition of Y on first page of

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Strunk, right column) and X3 to be hydrogen (see definition of R1 on first page of Strunk, right column).

This is a request for continuation. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/  
Examiner  
Art Unit 1625

/Rita J. Desai/  
Primary Examiner, Art Unit 1625